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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,363	09/25/2001	Takenori Idehara	011350-287	5946

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EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/961,363	Applicant(s) IDEHARA ET AL.	
	Examiner Ramsey M Refai	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/24/2002</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-65 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-11, 15-24, 26-32, 34-41, and 44-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al (U.S. Patent No. 6,515,988).

4. As per claim 1, Eldridge et al teach a system comprising:

a first device connected to a network (**column 9, lines 24-29; remote file server**);

a second device connected to said network (**column 1, lines 37-42; network printer**)

and

at least one portable terminal (**column 1, lines 37-42; handheld portable computer**),

wherein device information of said first device containing connection information for establishing a connection between said first device and said second device is, and later transmitted from said portable terminal to said second device, and therefore the connection

between said first device and said second device is established based on the device information **(column 2, lines 6-33)** transmitted from said first device to said portable terminal **(column 1, lines 29-35, column 6, lines 56-62 and column 7, lines 47-54; shows the device can accept tokens, which can be from the first device, and column 8, lines 55-60; shows a token passed from PDA A to PDA B).**

5. As per claim 2, Eldridge et al teach data is transmitted between said first device and said second device after said connection is established **(column 1, lines 37-42; network printer retrieves the document after beaming of document location information).**

6. As per claim 3, Eldridge et al teach said device information is transmitted from said first device to said portable terminal via a mobile telecommunication network **(column 8, lines 55-60; shows a token passed from PDA A to PDA B using IR).**

7. As per claim 4, Eldridge et al teach said device information is transmitted from said first device to said portable terminal via a communication means for communicating in short distances **(column 8, lines 55-60; shows a token passed from PDA A to PDA B using IR).**

8. As per claim 5, Eldridge et al teach said communication means for communicating in short distances is a wireless communication means **(column 3, lines 35-40).**

9. As per claim 6, Eldridge et al teach said communication means for communicating in short distances is based on either Bluetooth., IEEE 802.11, Home RF, or IrDA (**column 5, line 59**).

10. As per claim 7, Eldridge et al teach said communication means for communicating in short distances is a wired communication means (**column 6, lines 5-15**).

11. As per claim 8, Eldridge et al teach said device information is transmitted from said portable terminal to said second device by means of a communication means for communicating in short distances (**column 1, lines 37-42; document's URL is beamed from portable computer to network printer**).

12. As per claim 9, Eldridge et al teach said communication means for communicating in short distances is a wireless communication means (**column 3, lines 35-40**).

13. As per claim 10, Eldridge et al teach which said communication means for communicating in short distances is based on either Bluetooth., IEEE 802.11, Home RF, or IrDA (**column 5, line 59**).

14. As per claim 11, Eldridge et al teach said communication means for communicating in short distances is a wired communication means (**column 6, lines 5-15**).

15. As per claim 15, Eldridge et al teach at least one portable terminal consists of two portable terminals, one of the portable terminals receives the device information from said first device (**column 9, line 26; file servers are known to contain an interface to transmit any type of information, and column 1, lines 29-34; the portable device can receive document information,**) and transmits it to the other of the portable terminals and the other of the portable terminals transmits the received device information to said second device (**column 8, line 28-column 9, line 4, and Figures 4-5**).

16. As per claim 16, Eldridge et al teach said device information is transmitted from said one of the portable terminals to said other portable terminal via a mobile telecommunication network (**column 8, lines 55-59; token passed wirelessly from PDA A to PDA B**).

17. As per claim 17, Eldridge et al teach connection information contains an identification code for identifying said first device on said network (**column 2, lines 6-33**).

18. As per claim 18, Eldridge et al teach said identification code is an IP address (**column 2, lines 26-33**).

19. As per claims 19-24, 26-32, 34-41, and 44-65, these claims are similar to claims 1-11 and 15-18, therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 13-14, 25, 33, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (U.S. Patent No. 6,515,988) in view of Jones (U.S. Patent No. 6,145,046).

22. As per claim 13, Eldridge et al fail to teach said portable terminal is a memory medium.

23. However Jones teaches the use of a memory card (**abstract, lines 1-4 and Figures 1A-1C**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Eldridge et al and Jones because Jones' use of a memory card in Eldridge et al's system would allow for document information such as document location to be transferred to a memory card, which then is transferred to a network printer using a memory card user providing an easy way to securely print documents.

24. As per claim 14, Eldridge et al teach said first device comprises an interface for transmitting device information (**column 9, line 26; file servers are known to contain an interface to transmit any type of information, and column 1, lines 29-34; the portable device can receive document information,**) and said second device comprises an interface for receiving the device information transmitted (**column 2, lines 7-33; network printer receives beam of token containing document location information**).

25. Eldridge et al fail to teach the use of sending information to and from a memory medium.

26. However, Jones teaches a memory card that records image frames captured by a digital camera. The memory card then can be inserted into a slot for receiving a memory card on a laptop before being printed (**column 3, lines 11-31**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Eldridge et al and Jones because Jones' use of a memory card in Eldridge et al's system would allow for document information such as document location to be transferred to a memory card, which then is transferred to a network printer using a memory card user providing an easy way to securely print documents.

27. As per claims 25, 33, and 43, these claims contain similar limitations as claims 13-14 above, therefore are rejected under the same rationale.

28. Claims 12 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (U.S. Patent No. 6,515,988) in view of "Official Notice".

29. As per claim 12 and 42, Eldridge et al teach the use of portable devices (**column 1, lines 24-29**).

30. Eldridge et al fails to specifically teach that a portable device can be a mobile telephone.

31. However, "Official Notice" is taken that both the concept and advantages of using a mobile telephone is well known and expected in the art. It would have been obvious to one of the ordinary skill in the art to use a mobile telephone with Eldridge et al because most professionals

carry mobile telephones and it would be convenient to them to use a mobile telephone for multi purposes without the need to carry another portable device for transmitting data such as document information.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Picoult et al (U.S. Patent No. 6,801,932)
- b. Yeh (U.S. Patent No. 5,666,495)
- c. Suemoto et al (U.S. Patent No. 6,194,712)
- d. Murata (U.S. Patent No. 6,606,161)
- e. Yamauchi (U.S. Patent No. 6,819,917)
- f. Brittenham et al (U.S. Patent No. 5,905,486)
- g. Winter et al (U.S. Patent Publication No. 2001/0040685)
- h. Chan et al (U.S. Patent No. 6,378,070)
- i. Nykanen et al (U.S. Patent No. 6,285,889)
- j. Lammings et al (U.S. Patent No. 5,862,321)
- k. Eldridge et al (U.S. Patent No. 6,397,261).

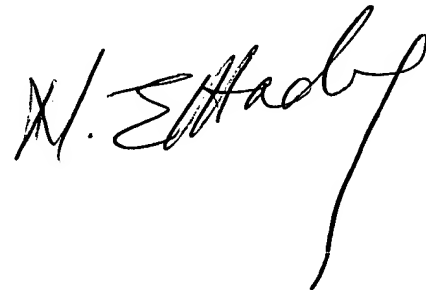
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey M Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey M Refai
Examiner
Art Unit 2154

RMR
November 21, 2004

A handwritten signature in black ink, appearing to read 'R. M. Refai', with a long, sweeping vertical stroke extending downwards from the end of the signature.